Supreme Court, U.S.
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No. 85-20

In The
Supreme Court of the United States
October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

v.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF RESPONDENT CHEMTROL ADHESIVES, INC. IN OPPOSITION

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QUESTIONS PRESENTED FOR REVIEW

1. Whether the District Court properly granted, and the Court of Appeals properly upheld, summary judgment to Chemtrol holding invalid U.S. Letters Patent 3,900,645 on collateral estoppel grounds where the U.S. Court of Customs and Patent Appeals held the claims not patentable, and after Morgan litigated the patentability of the claims for five (5) years?

2. Whether the Courts below properly held that the U.S. Court of Customs and Patent Appeals had jurisdiction over reissue proceedings concerning U.S. Letters Patent 3,900,645, where a reissue patent could have issued to Morgan had allowable subject matter been found?

3. Whether the District Court properly held that Morgan may not challenge the subject matter jurisdiction of the U.S. Court of Customs and Patent Appeals by collateral attack where Morgan invoked the jurisdiction of the Court and made no challenge to jurisdiction before the C.C.P.A. or on direct review?

4. Whether Morgan has set forth any ground under Rule 17 of this Court why the decisions below ought to be reviewed by this Court?

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OPINIONS

In addition to those Opinions listed in the Petition, the following are relevant to this proceeding:

1. Patent Board of Appeals' Denial of Morgan's Request for Reconsideration (A. 97)
2. Court of Customs and Patent Appeals Denial of Morgan's Petition for Rehearing (A. 99)
3. Patent Office's Rejection of Morgan's Continued Reissue Application (A. 100)

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STATUTES AND REGULATIONS

In addition to those cited in the Petition, this action involves the following statutes and regulations, the text of which are set forth in the Appendix to the brief:

1. 35 U.S.C. § 102(b)
2. 35 U.S.C. § 103
3. 35 U.C.S. § 112
4. 35 U.S.C. § 132
5. Manual of Patent Examining Procedure § 716

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STATEMENT OF THE CASE

Because Petitioner Morgan Adhesives Company's Statement of the Case excludes highly relevant events crucial to this Court's understanding of this Petition, Respondent Chemtrol Adhesives, Inc.[1] presents a comprehensive statement of the relevant procedural and factual events below.

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[1] Chemtrol Adhesives, Inc. has no parent company and no subsidiaries.

Petitioner Morgan and Respondent Chemtrol are competitors in the adhesive laminate industry. Chemtrol was founded in 1973 by Harold Robinson, a former Morgan employee. Both companies are located between Cleveland and Akron in Northeast Ohio. Morgan filed this patent infringement and unfair competition action for damages and injunctive relief in the United States District Court for the Northern District of Ohio on February 2, 1976. Between 1976 and May 20, 1983, when that court entered summary judgment for Chemtrol on collateral estoppel grounds, the primary patent claim raised by this action also proceeded through the United States Patent and Trademark Office (the "Patent Office"), the Board of Appeals therein, and ultimately to the United States Court of Customs and Patent Appeals ("CCPA"). Having no success before any of the above bodies, Petitioner returned to the District Court, which subsequently granted summary judgment on that patent claim, the balance of the claims having been dismissed by Morgan. (A. 15).

Morgan filed its Complaint on February 2, 1976. After limited discovery, Morgan, on September 20, 1977, moved to stay proceedings below in order to file a reissue application with the Patent Office respecting U.S. Letters Patent No. 3,900,645 ("Patent '645"). (A. 41-3). This motion to stay was made apparently in response to Chemtrol's Answer and Counterclaim, alleging Patent '645 to be invalid, void and unenforceable on the basis of prior art not considered by the Patent Office during the patent's prosecution. As Morgan represented to the District Court, the reissue proceeding "allows a patentee to obtain reconsideration of a patent in view of prior art and other information relevant to patentability which may not have been previously considered by the USPTO." Brief in

Support of Plaintiff's Motion to Stay Proceedings at 1. (A. 108). Morgan placed the prior art raised by Chemtrol squarely before the Patent Office, stating in its Brief in Support of Plaintiff's Motion to Stay Proceedings, at 2:

> *The greatest expertise respecting the applicablity of prior art to the claimed invention resides in the USPTO* and the new rule provides the vehicle by which the Court may avail itself of such expertise. Further, *a substantial savings in time, money, and energy of not only the parties but also the Court will be realized if all concerned are allowed to gain the benefit of the consideration given by the USPTO to the issue of applicability of the Karn, Starr and Brady references to the claimed invention.*
>
> A further amendment to the rules, 35 CFR 1.291 [sic] (1977), allows members of the public to bring to the attention of the Patent Examiner such prior art, and papers related thereto, as may be deemed relevant to a patent's prosecution. Chemtrol is thus afforded an opportunity to advise the USPTO of its position regarding the applicability of the referenced prior art or any other prior art of which it may become aware. *Full consideration may thus be made of the prior art issues at bar via the expertise of the USPTO.*

(A. 109) (emphasis added).

Morgan filed its Reissue Application on September 19, 1977, and presented its full case to the Patent Examiner. (A. 57). *Morgan surrendered its original patent as part of its application.* (A. 76). In its Brief in Support, Morgan referred to the "great commercial success" of Patent '645. Four protesters, Chemtrol among them, presented their arguments to the Patent Office. Chemtrol received copies of all Office actions in the proceeding, and Morgan was required to serve any papers filed in the proceeding upon Chemtrol.

On October 11, 1978, the Examiner, in his first Office Action, rejected all of the claims of the reissue application on five alternate grounds. (A. 77). On January 9, 1979, Morgan responded to the Patent Office action and amended *both* the specification of the reissue application and independent claim 1 and dependent claim 4 thereof. (A. 44-6). In its Supplemental Response of February 20, 1979, Morgan again referred to the commercial success of Patent '645. The Examiner, in his Office Action of March 2, 1979, objected to the amendment to the specification because it contained new matter and because it was inaccurate and misdescriptive. The Examiner then made his action final. (A. 83).

After further proceedings resulted in a new final rejection, (A. 86), Morgan, on October 11, 1979, again amended both the claims and the specification of its reissue application stating, "In response to the final rejection dated July 13, 1979, kindly enter the following amendments . . ." (A. 47). In the amendment, Morgan deleted the amendatory matter provided in the amendment of January 10, 1979 as to the specification and substituted therefor a new amendment to the specification at page 5, line 25:

> As shown in Fig. 6, the paper backing layer may be less than one-half its uncompacted thickness at the potential tear line 18.

(A. 47). Morgan amended its claims 1 and 4 a second time "to conform to the language of those claims as originally filed." (A. 48). In its "Supplemental Response to Final Rejection," filed October 26, 1979, Morgan again referred to the commercial success of Patent '645.

On November 16, 1979, the Examiner advised Morgan that the Amendment of October 15, 1979 would be entered

upon the filing of a notice of appeal. (A. 91). Morgan's application on appeal thus consisted of claims that had been twice amended and a specification that had been twice amended. (A. 44, 47).

Failing to persuade the Examiner to withdraw his final rejection, Morgan appealed the decision of the Examiner to the United States Patent and Trademark Office Board of Appeals (the "Board"). Chemtrol was granted the right to participate fully in the appeal. In its Brief, Morgan twice recited the commercial success of Patent '645. Morgan and Chemtrol both were heard at the oral argument before the Board. The Board affirmed the Examiner's rejection of Morgan's reissue application claims on a number of grounds, among them the rejection of all claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103. (A. 4-11). Morgan thereupon requested the Board to reconsider its decision. The Board, in a two page opinion, denied the request for reconsideration. (A. 97-98).

Morgan then appealed the adverse Board decision to the United States Court of Customs and Patent Appeals ("CCPA"), an Article III court. Of course, in invoking the jurisdiction of the CCPA, Morgan did not assert that it was seeking only an "advisory opinion" from the Court. In its Brief, Morgan yet again recited the commercial success of Patent '645. Again, Chemtrol intervened and submitted a brief to the CCPA and participated in oral argument. Morgan, in addition to using the same series of charts purporting to demonstrate the scope of prior art as had been used before the Board, made a film presentation to the CCPA showing manufacturing processes and distributed samples of a product made by one of Morgan's experts. The Court affirmed the Patent Office's rejection of all claims of the reissue application under 35 U.S.C.

§ 103. (A. 12-14). Morgan petitioned the Court for rehearing, but was denied. (A. 99). At no time did Morgan question or challenge the jurisdiction of the CCPA, nor did Morgan at that time petition this Court for writ of certiorari.

Morgan subsequently abandoned its reissue application but, undaunted, filed a "continuation reissue application" in the Patent Office. Again, Chemtrol participated fully. On November 3, 1982, the Examiner rejected all claims of the continuation reissue application. (A. 100-08). Although the Examiner needed to tender only a single ground of rejection, he tendered four alternate and distinct grounds for rejection of all of the Morgan claims, among them being rejection of all claims on res judicata grounds, arising from the decision of the United States Court of Customs and Patent Appeals on the reissue appeal. *Id.* Morgan then abandoned its continuation reissue proceeding.

On January 24, 1983, Chemtrol moved for summary judgment as to the infringement claims relating to Patent '645 in the District Court below, maintaining that the CCPA's decision finding the claims of Patent '645 to be not patentable was determinative of that Patent's validity, and that Morgan was collaterally estopped from further arguing the validity of Patent '645. Chemtrol demonstrated that Morgan had received a full and fair hearing on the issue of the validity of Patent '645, and that every prerequisite for the application of collateral estoppel had been satisfied. Chemtrol submitted the Affidavit of Christopher B. Fagan, who had protested the reissue on behalf of Chemtrol, and attached extensive portions of the reissue record.

A flurry of briefing followed Chemtrol's initial motion and memorandum in support. Morgan's briefs included the assertions that the reissue proceeding was advisory only, that the decision of the CCPA was an advisory opinion, and further that collateral estoppel could not apply against Morgan because it had not received a full evidentiary hearing and had been denied due process.

The District Court granted Chemtrol's motion for summary judgment on May 20, 1983. (A. 15-34). In a lengthy opinion, the Court specifically addressed two arguments made by Morgan, the first of which Morgan has presented to this Court: (1) that the decision of the CCPA was advisory only; and (2) that there was no full and fair hearing in the reissue proceedings. The Court rejected both contentions. (A. 24). Following precedent of this Court, the District Court first held that any attack on the subject matter jurisdiction of the CCPA had to be by direct review, and not by collateral attack as Morgan was attempting to do. (A. 29-30). Second, the Court found that, by virtue of Morgan's amendments of the claims and specification of its reissue application, a true reissue proceeding occurred therein. (A. 28-9). Third, the Court agreed with Chemtrol that *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 U.S.P.Q. 367 (C.D. Cal. 1977), and *W.F. Altenpohl, Inc. v. Gainesville Machine Co.*, 185 U.S.P.Q. 500 (N.D. Ga. 1974), not even cited by Morgan in its Petition, are "dispositive of the question presented in this case." (A. 33). The Court further found Morgan's contention that it was denied a full and fair hearing to be "utterly without merit." *Id.* Finally, the Court dealt with Morgan's claim of due process violations, finding this claim also to be "without merit." (A. 34 n.16).

Morgan appealed the decision of the District Court to the Court of Appeals for the Federal Circuit. In its Brief, Morgan reiterated its "due process" argument at some length. Morgan also repeated its contention that the reissue proceedings were advisory only. Morgan did not attempt to distinguish, nor did it even cite, the two cases the District Court had found to be "dispositive."

On February 7, 1985, the Federal Circuit affirmed the decision of the District Court on the ground of collateral estoppel, specifically finding that Morgan had converted its reissue application into a statutory reissue, thereby obviating Morgan's attack on the jurisdiction of the CCPA. (A. 1-3). The Court further specifically found that Morgan had not been denied due process of law. (A. 3).

Morgan now petitions this Court for a writ of certiorari on the same grounds that have been rejected in the courts below. Based upon the authorities below, and for the reasons which follow, Morgan's petition should be denied.

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ARGUMENT

I. The Courts Below Held Correctly That Morgan Is Collaterally Estopped From Relitigating The Validity Of U.S. Letters Patent 3,900,645.

The Courts below held correctly that Morgan is collaterally estopped from relitigating the validity of Patent '645. The doctrine of collateral estoppel acts to conserve judicial resources by preventing a party from litigating the same issue more than once:

> Under collateral estoppel, once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is conclusive in subsequent suits based on a different cause of action involving a party to the prior litigation.

Montana v. United States, 440 U.S. 147, 154 (1979). Although variously stated, the doctrine has four main elements. First, the issue involved in the action in which estoppel is asserted must be the same as, or embraced within, an issue involved in prior adjudication. Second, there must have been a final judgment on the merits in the prior action. Third, the estopped party must have been a party or in privity with a party to the prior adjudication. Fourth, the estopped party must have had a full and fair opportunity to be heard on the issue in question. *Oldham v. Pritchett,* 599 F.2d 278, 279 (8th Cir. 1979); *Westwood Chemical, Inc. v. Molded Fiber Glass Body Co.,* 498 F.2d 1115, 1116, 1119 (6th Cir. 1974). The Courts below correctly found that all of these elements are satisfied here.

In the context of patent litigation, the landmark case concerning collateral estoppel is *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation,* 402 U.S. 313 (1971), quoted extensively by the District Court. (A. 22-23). In *Blonder-Tongue,* this Court addressed the respective burdens of proof upon the parties when collateral estoppel is raised. If the defendant raises estoppel, the defendant has the burden of showing that the plaintiff seeks to relitigate the same issue decided adversely to the plaintiff in the prior case. The plaintiff must then prove, "if he can," that he did not have a fair opportunity to litigate the claim the first time. 402 U.S. at 802. The factors to be evaluated when examining whether a full

and fair opportunity to litigate was afforded were explained by this Court in *Blonder-Tongue* (and quoted by the District Court) as follows:

> Determining whether a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case is of necessity not a simple matter. *In addition to the considerations of choice of forum and incentive to litigate* mentioned above, certain other factors immediately emerge. For example, if the issue is nonobviousness, *appropriate inquiries would be whether the first validity determination purported to employ the standards announced in Graham v. Deere Co., supra; whether the opinions filed by the District Court and the reviewing court, if any, indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues in suit; and whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation.* But as so often is the case, no one set of facts, no one collection of words or phrases, will provide an automatic formula for proper rulings on estoppel pleas. In the end, decision will necessarily rest on the trial court's sense of justice and equity.

(A. 23) (quoting 402 U.S. at 333-34) (footnote omitted) (emphasis in original); *see Stevenson v. Sears, Roebuck & Co.*, 713 F.2d 705, 709 (Fed. Cir. 1983). The above standard was correctly applied by the Courts below.

The second and third elements of collateral estoppel mentioned above may be dealt with summarily. There is no dispute that the CCPA reached a final judgment on the merits of the patentability of the claims of Patent '645. The purported issue of the Court's jurisdiction will be dealt with below. Likewise, there is no dispute that Morgan was a party to the prior reissue litigation.

The only two issues remaining for the application of collateral estoppel are: (1) identity of issues; and (2)

whether Morgan received a full and fair opportunity to litigate.

A. The U.S. Court of Customs and Patent Appeals' Affirmance of the Rejection of the Claims of the Reissue Application Is Equivalent to a Finding of Invalidity of Patent 3,900,645.

The issue before the Patent Office, the Board of Appeals, and the CCPA was the patentability of the claims of the reissue application, and therefore necessarily the validity of Patent '645. The Courts below could not have found Patent '645 valid without contradicting the judgments of the Patent Office and the CCPA that the claims of this patent are unpatentable. Similarly, the Courts below could not have found Patent '645 infringed without finding it valid, again contradicting the judgment of the forums Morgan chose to litigate the patentability of the claims of this patent. *See Westwood Chemical, Inc. v. Molded Fiber Glass Body Co.*, 380 F. Supp. 517, 527 (N.D. Ohio 1973), *aff'd*, 498 F.2d 1115 (6th Cir. 1974). Thus, the issue of validity of Patent '645 is necessarily embraced within and identical to the issue decided adversely to Morgan by the CCPA and the Patent Office.

That identity of issues exists in this action becomes even clearer upon examination of the two cases the District Court found "dispositive of the question presented in this case" (A. 33), and which Morgan did not even attempt to distinguish in its Petition. In *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 U.S.P.Q. 367 (C.D. Cal. 1977), presenting "facts nearly identical to those before this Court" (A. 30), the matter before the court was defendants' motion for summary

judgment on collateral estoppel grounds. 194 U.S.P.Q. at 368. As in the instant case, the plaintiff in *Computer Products* brought a patent infringement suit in federal court. The parties "vigorously prosecuted and defended the action" for two years, until plaintiff filed an application for reissue of its patent with the Patent Office. The case lay dormant in federal court while plaintiff pursued the reissue proceedings.

The Patent Office ultimately rejected the reissue application. Plaintiff appealed to the Board of Appeals, which affirmed the rejection. 194 U.S.P.Q. at 368. The plaintiff then appealed to the CCPA. After the CCPA rendered its decision, plaintiff filed a continuation reissue application in the Patent Office. *Id.* at 369. The Patent Office again rejected the claims of plaintiff's application. The Court in *Computer Products* then addressed defendant's motion for summary judgment and held:

> The decision in Blonder-Tongue approves a plea of estoppel in patent cases where the party asserting the patent had enjoyed a full opportunity to present his side of the case. Blonder-Tongue concerned the effect of a judgment in one patent infringement suit on another infringement suit on the same patent. Where, as here, the litigation centered in the Court of Customs and Patent Appeals, and concerned whether a patent even exists, the logic of Blonder-Tongue is even more compelling. *Plaintiff cannot create a patent in this Court; he must first have one authorized by the Patent Office. Once the Court of Customs and Patent Appeals finally decides that he has no patent, this Court cannot entertain a claim of infringement.*
>
> . . . .
>
> *Plaintiff has long represented to this Court that we should have the benefit of the expertise of the Pa-*

> *tent Office. Now that we have that benefit, plaintiff would have us ignore it because the expertise weighs against him. We decline to follow such an approach.*

(A. 31) (quoting 194 U.S.P.Q. at 369-70) (emphasis in original). The Court in *Computer Products*, viewing facts almost identical to those of this action, granted summary judgment for defendant. The District Court also correctly cited *W.F. Altenpohl, Inc. v. Gainesville Machine Co.*, 185 U.S.P.Q. 500 (N.D. Ga. 1974), as being dispositive of the instant case. (A. 32-3).

Computer Products and *Altenpohl* demonstrate clearly that an adverse determination by the Court of Customs and Patent Appeals in reissue proceedings estops Morgan from later relitigating the validity or the infringement of the patent in issue therein, and for this reason, the Courts below held correctly that any part of Morgan's claim relating to Patent '645 is properly disposed of by summary judgment in favor of Chemtrol. Understandably, Morgan fails to cite this precedent, and indeed asserts that it does not exist.[2]

B. Morgan Had a Full and Fair Opportunity to Litigate the Validity of Its Patent in Reissue Proceedings.

The Courts below also found that Morgan had a full and fair opportunity to litigate. The District Court held Morgan's contentions to the contrary in this regard to be "utterly without merit":

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[2] At p. 16 of its Petition, Morgan states that "No reissue proceeding invalidates a patent. But in our case, two courts [those below] have held that it does." In reality, at least four courts have so held.

> During the five (5) years that Morgan was before the patent office, the board of patent appeals and the CCPA, it filed numerous briefs and reply briefs, presented affidavits of experts, used deposition testimony taken in discovery in this case and orally argued validity twice. Indeed when it was before the CCPA Morgan presented a movie and distributed samples of its product. In *Kaiser Industries Corp. v. Jones & Laughlin Steel Corp., supra,* the Court of Appeals for the Third Circuit construed the decision of the United States Supreme Court in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, supra,* and held:
>
> > *The guidelines suggested for reaching a result permitting relitigation are replete with qualifying words making a patentee's burden onerous. In effect, a patentee must persuade a second trial court 'that the prior proceedings were seriously defective.'*
>
> (Footnote omitted) (emphasis added). The court holds that Morgan has failed to meet its burden of showing "that the prior proceedings were seriously defective."

(A. 33; *see* A. 3) (emphasis in original).

Perhaps most telling of the nature and scope of the Patent Office proceedings regarding Patent '645 is Plaintiff's own Request for Additional Time for Oral Argument before the Board of Appeals:

> The need for additional time to fairly present appellant's case is further supported by the *sheer volume of material* lodged during the prosecution before the Examiner and before this Board on Appeal . . . The requested five (5) minute rebuttal period would afford appellant a minimum of time necessary for a *full and fair hearing.*

(A. 111-12) (emphasis added) (the request was granted).

Undaunted by the specific findings against it below, Morgan has argued in its Petition, for the first time in this action, that it did not receive a full and fair hearing "because it never had the opportunity to argue commercial success of its patent." Petition at 230. This assertion is patently false. Not only did Morgan have the opportunity to argue commercial success, *it did so* at several points during the reissue proceeding. These are set forth, in part, in the statement of the Case, *supra,* at 3-5.

Despite the facts Morgan asserts that commercial success "was not considered, and would not have been relevant, to the no-defect proceeding." Petition at 21. Understandably, no citation follows this assertion, which is yet another attempt to mislead this Court. Manual of Patent Examining Procedure § 716(4), provides that "Affidavits or declarations submitting evidence of commercial success . . . must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103." Morgan had the opportunity to, and did, argue commercial success following the Examiner's rejection of Patent '645 under 35 U.S.C. § 103. Morgan's assertion to the contrary is disingenuous at best.

In view of the length of time and intensity with which Patent '645 was litigated, before the bodies that Morgan admitted have "the greatest expertise" regarding these matters, the Courts below held correctly that Morgan had a full and fair opportunity to litigate the validity of Patent '645. This Court should, therefore, deny Morgan's Petition.

II. The Courts Below Held Correctly That The U.S. Court Of Customs And Patent Appeals Had Jurisdiction Over Morgan's Appeal Of Adverse Patent Office Actions On Reissue.

A. The Reissue Proceeding Concerning Patent '645 Was Not an Advisory Reissue.

In its Petition, Morgan argues in the face of specific findings below that its reissue application regarding Patent '645 was advisory only and that such application could not be converted into an adjudicatory proceeding. Petition at 13-16. Review of the facts and applicable law, however, demonstrates that Morgan prosecuted a true reissue application, and that a reissue patent could have issued had allowable subject matter been found.

In the first Official Action of the Patent Office, the Examiner rejected the Morgan reissue claims on five (5) alternate grounds, including rejections under 35 U.S.C. § 112 (first paragraph), 35 U.S.C. § 112 (first and second paragraphs), 35 U.S.C. § 102(b) (based on Karn), 35 U.S.C. § 103 (based on Karn in view of Brady or Brady, Jr.), and 35 U.S.C. § 103 (based on Karn in view of *Cameron Bulletin*). (A. 78-81). In addition, the Examiner objected to the specification for lack of an antecedent basis therein for the limitation of claim 3. (A. 78).

In response to the Patent Office Action,[3] Morgan amended the specification by inserting at page 5, line 25, the following language:

> As shown in FIGURE 6, the lines 18 of the processed sheet 12 are compacted to a reduced thickness which

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[3] Morgan's printing of the Appendix characterizes the Morgan response of January 9, 1979 as "Morgan's Amended Reissue Application." (A. 44).

> may, for example, be less than one-half of the thickness of the sheet 12 proper.

(A. 44). In addition, Morgan amended independent claim 1 and dependent claim 4. (A. 44-5). In amending the claims, Morgan stated "These amendments have been made to correct the shortcomings of claims 1 and 4 as noted in paragraph 2 of the Office Action . . ." (A. 45).

In the Official Action that followed, the Examiner objected to the amendatory matter inserted in the specification as containing new matter and as being inaccurate and misdescriptive. (A. 84). The Examiner then rejected claims 1-4 under 35 U.S.C. § 132 as being based on new matter and under 35 U.S.C. § 112 (first and second paragraphs). (A. 84). In addition, the Examiner repeated the five (5) grounds of rejection of the claims as noted in the first Official Action. (A. 85). At this time, the Examiner made his action final. *Id.*

Subsequently, the Examiner withdrew the final rejection in favor of a new final rejection which issued on July 9, 1979. (A. 86-90). In the new final rejection, the Examiner responded to arguments raised by Morgan and, in addition, repeated the previous objections and rejections of all of the claims set out in the prior Official Action. *Id.*

In response to the final rejection of July 13, 1979, Morgan deleted the earlier amendment to the specification in favor of a substituted amendment to the specification which read as follows:

> As shown in FIGURE 6, the paper backing layer may be less than one-half of its uncompacted thickness at the potential tear line 18.

(A. 47). Morgan made this amendment to the specification:

> [T]o conform to the helpful suggestion of the Examiner as set forth in the Office Action dated March 2, 1979. Particularly, line 25 of page 2 has been amended to include the acceptable language of claim 3 with respect to the nature of the potential tear line 18.

(A. 48). In addition, Morgan amended its claims 1 and 4 a second time "to conform to the language of those claims as originally filed."[4] *Id.*

In the appeal to the Board of Appeals that followed, the Examiner's rejections of the claims under 35 U.S.C. § 102(b) (based on Karn), 35 U.S.C. § 103 (based on Karn in view of Brady ('732) or Brady ('545) and 35 U.S.C. § 103 (based on Karn in view of the *Cameron Bulletin)* were affirmed. In view of the breadth of this affirmance, Morgan's contention that the Board "merely decided whether the PTO correctly refused to reflect on the original patent record that certain prior art had been considered," Petition at 16, is patently false. (A. 4-11). Morgan's request for reconsideration was denied. (A. 97). Morgan then appealed to the CCPA.

As the case came to the CCPA, the *claims* were in the same form which had originally issued from the Patent Office in Patent '645 although, as noted above, two amendments had been made to the claims during the prosecution before the Examiner. The second amendment brought the claims back into conformity with the original claim language of Patent '645. The specification, however, had

---

[4] Morgan's printing of the Appendix characterizes the Morgan response of October 11, 1979 as "Morgan's Amendments to Reissue Application." (A. 47).

been amended — twice — ending up in a form *different* from that of the original Patent '645 as noted above. Were this an "advisory" reissue, *none* of the above amendments could have been made.

The Courts below properly recognized that a change in the specification was enough to convert this reissue from an advisory to a "true" reissue proceeding. As stated by the Court of Appeals:

> Although appellant withdrew its amendments to the claims, it did not withdraw its amendment to the specification. Appellant, in fact, admits in its brief "as the case came to the CCPA the patent was in precisely the same form in which it had originally issued from the Patent Office, *except* only for the insertion of one sentence in the specification." (Emphasis added). The sentence was added to overcome a rejection of claim 3 based on the lack of antecedent basis for the limitation in claim 3. *The change thereby converted the application into a statutory reissue application.*

(A. 2) (emphasis added). The Court of Appeals then distinguished *In re Bose,* 687 F.2d 432 (C.C.P.A. 1982), and *In re Dien,* 680 F.2d 151 (C.C.P.A. 1982), relied on by Morgan:

> In both cases the proceedings were held to be advisory only. The basis for those conclusions was that no reissue patents could have issued that would have differed from the original patents because no new specifications or claims were present in the reissue applications. By contrast, *in the present case, had the Court of Customs and Patent Appeals (CCPA) reversed the rejection, appellant would have received a new patent containing new language* . . . . The proceedings in the Patent and Trademark Office (PTO) *were therefore not advisory in this case.*

(A. 2) (emphasis added).

Morgan goes to great lengths in its Petition to state that it was only seeking an advisory opinion all along. Curiously, Morgan does not cite to any part of the voluminous record to support this assertion. The reason is clear — there is no such support. Morgan also argues that because it labeled its reissue as advisory under 37 C.F.R. § 1.175(a)(4), it must have, therefore, been merely an advisory reissue. This same argument was rejected in *In re Bose, supra,* where the applicant refused to execute a reissue oath or declaration and argued that the entire proceeding was advisory. In response, the CCPA noted:

> [T]he label attached by the PTO or appellant to a reissue proceeding, whether it be (a)(3) or (a)(4), is not determinative of whether a case or controversy exists for purposes of Article III of the Constitution of the United States.

687 F.2d at 435.

The *Bose* case, besides demonstrating the unimportance of the label placed on a reissue application, also answers Morgan's argument that its reissue application did not have a proper separate declaration or oath to support it, as required under 37 C.F.R. § 1.175(a)(3). The placing of an affidavit in the file is a matter of formality and need not be done until the reissue patent is ready to issue. The Examiner has discretion to accept a new or supplemental oath at any time during the prosecution of the application. Because Morgan's reissue application was never in condition for allowance, it was not necessary for the Examiner to request the filing of a suitable oath or declaration pursuant to 37 C.F.R. § 1.175(a)(3). In *Bose,* the Board of Appeals, in compliance with the mandate of MPEP § 1404.02, concluded that appellant had in effect

converted his reissue application from an (a) (4) to an (a) (3) application, though no new oath or declaration had been filed. 687 F.2d at 434. Thus, the absence of such an oath does not affect the classification of a reissue, which is, in any event, unimportant. *See Cutter Co. v. Metropolitan Electric Manufacturing Co.*, 275 F. 158 (2d Cir. 1921) (supplemental oaths may be accepted even after the case is allowed).

In summary, Morgan prosecuted a reissue application in which two amendments were made to the specification and two amendments were made to claims 1 and 4. The amendments to the specification clearly could have resulted in the issuance of a reissue patent had the CCPA found allowable subject matter. The Courts below, therefore, were correct in holding that Morgan converted its application from an advisory to a "true" reissue.

B. Morgan Was Not Denied Due Process.

Morgan's arguments in its Petition that it was denied due process because it did not voluntarily surrender its patent (which it actually had done) and because the Courts below somehow converted its reissue from advisory to "regular" is again contrary to the facts in this case and the applicable law. *Morgan*, and not the courts below, converted its reissue application from a 37 C.F.R. § 1.175(a)(4) reissue to an (a)(3) reissue. The conversion was not without warning — it was, in fact, performed by Morgan itself when it amended both its specification and claims.[5] At that point in time, Morgan knew that it

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[5] Morgan's assertion at p. 16 of its Petition that "any conversion which took place was performed by the Courts in this case, not by Morgan," is patently false and directly contrary to MPEP § 1414.02, quoted by Morgan in its next paragraph.

was no longer seeking merely an advisory opinion but that it was, rather, attempting to obtain allowance of amended claims with reference to an amended specification, all in response to objections and rejections made by the Examiner. Morgan's protestations that it has been subjected to a conversion without warning of its reissue application ignore the facts that:

(a) Morgan filed its reissue application and actually surrendered Patent '645 to the Patent Office after litigation was commenced against Chemtrol voluntarily and with full knowledge of the Patent Office reissue statutes (A.76);

(b) Morgan voluntarily filed a motion to stay proceedings in the United States District Court during the pendency of its reissue application;

(c) Morgan voluntarily amended its specification and claims on two occasions in response to Examiner objections and rejections;

(d) Morgan voluntarily appealed the adverse decision of the Patent Office Examiner to the Board of Appeals;

(e) Morgan voluntarily appealed the adverse decision of the Patent Office Board of Appeals to the CCPA;

(f) Morgan voluntarily petitioned for a rehearing in the CCPA. In its petition, Morgan made no reference to the CCPA's alleged lack of jurisdiction; and

(g) Morgan voluntarily elected not to file a petition at that time for a writ of certiorari in this Court but, rather, elected to:

(i) Voluntarily file a continuation reissue application in the Patent Office; and

(ii) Voluntarily abandon its continuation reissue application after the first action in which the Examiner continued to reject all of the claims.

Morgan's own actions clearly distinguish its reissue applications from any semblance of an advisory proceeding; Morgan cannot be heard to complain now because the results of its actions are not to its liking. The Courts below held correctly that Morgan was not denied due process.

III. The Courts Below Held Correctly That Morgan May Not Collaterally Attack The Subject Matter Jurisdiction Of The United States Court Of Customs And Patent Appeals.

Fundamentally, Morgan's Petition is an attack on the prior judgment of the CCPA in Morgan's reissue proceeding. The District Court opinion, while demonstrating that Morgan's position on the prior CCPA judgment is without merit, also properly rebuffs Morgan's attempt to collaterally attack the CCPA judgment. (A. 27-30).

Morgan argues that because the CCPA recently decided in *In re Dien*, 680 F.2d 151 (C.C.P.A. 1982), that it no longer had jurisdiction over *advisory* reissue proceedings, that, therefore, the prior judgment of the CCPA against it must have been "in the teeth" of precedent[6]

---

[6] Morgan seems to assert that the CCPA decided Morgan's appeal—in 1981—in the teeth of "precedent" decided in 1982 that no jurisdiction existed. No further comment on this position seems necessary, other than to say that it cannot possibly be taken in good faith.

that jurisdiction does not exist. Petition at 19. Chemtrol has already demonstrated, *supra,* that the District Court was correct in holding that Morgan's reissue was not an advisory one. However, it is clear that Morgan may not attack the CCPA's judgment in any event before this Court, because the CCPA's assumption of subject matter jurisdiction on reissue is res judicata and no longer subject to attack.

The District Court dealt with the issue of collateral attack at some length below:

> In *Chicot County Drainage Dist. v. Baxter State Bank,* 308 U.S. 371, 60 S. Ct. 317 (1940), the United States Supreme Court held that although subject to "direct review," a determination by a federal court that it sustains subject matter jurisdiction over a cause of action "*may not be assailed collaterally.*" 308 U.S. at 376, 60 S. Ct. at 319 (Emphasis added). The Court of Appeals for the Third Circuit has held:
>
> > It was settled long ago by *Chicot County Drainage District v. Baxter State Bank,* 308 U.S. 371, 60 S. Ct. 317, 84 L.Ed. 329 (1940), that when a federal court proceeds to final judgment on the merits, the issue of its subject matter jurisdiction is res judicata even though it was not litigated or, indeed, even though the decree was totally uncontested.
>
> *Hodge v. Hodge,* 621 F.2d 590, 592 (3d Cir. 1980) (footnote omitted).

(A. 27-28).

Morgan made no attempt to assail the CCPA's subject matter jurisdiction either before the CCPA or on direct review, though it had two opportunities to do so subsequent to the CCPA's adverse adjudication of Morgan's appeal from the Patent Office Board of Appeals. First,

Morgan could have raised the issue, but did not, in its petition for rehearing to the CCPA. Second, Morgan could have petitioned for certiorari to this Court at that time. Morgan failed to do so. Collaterally, Morgan now asserts the anomalous position of attacking the jurisdiction of the CCPA after deliberately invoking it, in the hope of somehow obtaining a different result. This it cannot do.

In support of its holding, the District Court cited the landmark case of *Chicot County Drainage District v. Baxter State Bank,* 308 U.S. 371 (1940). In *Chicot,* this Court addressed a situation similar to that before the Courts below and now on appeal to this Court. This Court addressed the collateral attack of a decision under a statute later declared unconstitutional. The Court denied the propriety of the collateral attack:

> The lower federal courts are all courts of limited jurisdiction, that is, with only the jurisdiction which Congress has prescribed. But nonetheless *they are courts with authority, when parties are brought before them in accordance with the requirements of due process, to determine whether or not they have jurisdiction to entertain the cause and for this purpose to construe and apply the statute under which they are asked to act. Their determinations of such questions, while open to direct review, may not be assailed collaterally.*
>
> . . . .
>
> The remaining question is simply whether respondents have failed to raise the question in the proceeding to which they were parties and in which they could have raised it and had it finally determined, were privileged to remain quiet and raise it in a subsequent suit. Such a view is contrary to the well-settled principle that res judicata may be pleaded as a bar, not only as respects matters actually presented to

> sustain or defeat the right asserted in the earlier proceeding, "but also as respects any other available matter which might have been presented to that end."

308 U.S. at 376 (quoting *Grubb v. Public Utilities Commission,* 281 U.S. 470 (1930)) (emphasis added). Because Morgan attempts to collaterally attack the jurisdiction of the CCPA, after deliberately invoking it, its Petition should be denied.

IV. Morgan Has Failed To Set Forth Any Reasons Why Its Petition Should Be Granted.

Rule 17 of the Rules of the Supreme Court of the United States provides that review on writ of certiorari "will be granted only when there are special and important reasons therefor." The Rule then lists several reasons which "indicate the character of reasons that will be considered." *See General Talking Pictures Corp. v. Western Electric Co.,* 304 U.S. 175, 178 (1937) (granting writ "would not be warranted merely to review the evidence or inferences drawn from it . . . concurrent findings [by Courts below] . . . are not to be disturbed unless plainly without support"); *Layne & Bowler Corp. v. Western Well Works, Inc.,* 261 U.S. 387, 393 (1923) (writ not granted "except in cases involving principles the settlement of which is important to the public as distiguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion between the circuit courts of appeal"). Morgan understandably does not cite nor attempt to comply with any portion of this Rule. Morgan's only colorable attempt at compliance is breathtaking but ridiculous. At p. 22 of its Petition, Morgan asserts that "This Court should grant certiorari to reverse a decision in conflict with its own proper decisions . . . ." After

making this assertion, *Morgan fails to cite a single decision of this Court that conflicts with the decisions below.* All that appears, for the first time, is a "suggestion" that this Court "should further reexamine or clarify *Blonder-Tongue,*" a watershed case in both patent and procedural jurisprudence. Petition at 23. By so suggesting, Morgan recognizes that *Blonder-Tongue* and its progeny control in this action, and that its only hope is that this Court will overrule *Blonder-Tongue.*

In its Conclusion, Morgan again asserts that "a conflict has been created with decisions of this Court." Petition at 24. Zealous advocacy does not encompass willful misrepresentation and, for this reason alone, independent of the bankruptcy of Morgan's contentions, Morgan's Petition should be denied.

CONCLUSION

For all of the above reasons, Morgan's Petition should be denied.

Respectfully submitted,

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Attorneys for Respondent
Chemtrol Adhesives, Inc.

APPENDIX

35 U.S.C. § 102(b) provides as follows:

> A person shall be entitled to a patent unless —
>
> . . . .
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .

35 U.S.C. § 103 provides as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 112 provides as follows:

> The specification shall contain a writen description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 132 provides as follows:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of

> continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Manual of Patent Examining Procedure § 716 provides in pertinent part as follows:

> Affidavits or declarations submitting evidence of commercial success, long-felt but unsolved needs, failure of others, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103 . . . .

PATENT BOARD OF APPEALS' DENIAL OF MORGAN'S REQUEST FOR RECONSIDERATION

(Dated December 23, 1980)

ON REQUEST FOR RECONSIDERATION

This is a request for reconsideration of our decision of October 30, 1980, wherein we affirmed the rejection of all [2] the claims.

We note Protestor's memorandum.

Appellant contends that we have not properly interpreted the McKee and Ferrell affidavits. According to appellant, these affidavits clearly indicate that the Karn procedure may not be used to compress a backing paper or liner and that, when the described cutting takes place, it is either partial or complete, the partial cut paper remaining flexible.

Appellant's comments are basically the same as those set forth in the record before us. While Karn describes cutting through the liner, he also specifically describes an embodiment (column 3, line 59-73) in which channels

can be formed by crush-cutting rotary knives in which the liner fibers remain *unruptured* and become weakened at the channels. Such channels are readily ruptured when sharply bent and form a tab for removal of said liner. We have no valid reason to doubt that the product described by Karn is equivalent to that claimed. We are still of the opinion that one skilled in this art would clearly understand how to use the crush-cutter to obtain the result described by Karn.

Appellant's position would be tenable if Karn did not describe the final product. However, Karn clearly indicates a final product having the characteristics defined by appellant.

Appellant argues that the simultaneous rejection on Sections 103 and 102 is evidence that there is evidence that [3] there is uncertainty as to the teachings in Karn.

The examiner has the option of using any rejection which is appropriate, and we do not believe that the use of one rejection is prejudicial in any manner to the use of an alternative rejection.

We have reconsidered our decision as requested by appellant, but we decline to modify it in any respect.
DENIED

/s/ SAMUEL BLECH
Examiner-in-Chief

/s/ MURRAY KATZ
Examiner-in-Chief

BOARD OF APPEALS

/s/ IRVING PELLMAN
Examiner-in-Chief
(Acting)

COURT OF CUSTOMS AND PATENT APPEALS' DENIAL OF MORGAN'S PETITION FOR REHEARING

(Dated September 3, 1981)

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
717 Madison Place NW.
Washington, D.C. 20439

George E. Hutchinson
Clerk

September 3, 1981

Ray L. Weber, Esq.
Oldham, Oldham, Hudak & Weber
627 First National Tower
Akron, OH 44308

Re: Appeal No. 81-552
Ex parte Morgan

Dear Mr. Weber:

The court denied today the petition for rehearing in the above appeal.

Very truly yours,

/s/ GEORGE E. HUTCHINSON

cc: Solicitor
Christopher B. Fagan, Esq.

PATENT OFFICE'S REJECTION OF MORGAN'S CONTINUED REISSUE APPLICATION

(Dated November 1, 1982)

301140

Entered

CONTENTS

1. Applications papers
2. Letter Request filed Dec. 23, 1982
3. Ltr Draft A Ltr 11 pp
4. [illegible]
5. [illegible]
6. Dec Ltr Pet for Comment & Dec Ltr. for Exam, Aug 5, 198[illegible]
7. [illegible]
8. [illegible]
9. Appeal Brief 6 pages filed [illegible]
10. Reply of Ctrl. & Morgan Ltr Dec 3, 19[illegible]
11. Letter Comm Pats of Ctrl & Brief Rec'd
12. Reg Mailed Nov 3, 1983
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* * *

(SEAL)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

Serial Number, Filing Date, First Named Applicant, Attorney Docket No.

Examiner, Art Unit, Paper Number 12.

Date Mailed:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

[X] The applicaton has been examined. [X] Responsive to communication filed Nov. 1, 1982, Sept. 23, 1982, Oct. 22, 1982. [ ] The action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s) from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 36 U.S.C. 133.

Part 1. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION.

1. [X] Notice of References Cited by Examiner. PTO-892. 2. [ ] Notice of Informal Patent Drawing, PTO 948. 3. [ ] Notice of References Cited by Applicant, PTO-1449. 4. [ ] Notice of Informal Patent Application, Form PTO-152. 5.[ ]

Part II SUMMARY OF ACTION.

1. [ ] Claims 1-4 are pending in the application.

Of the above claims —— are withdrawn from consideration.

2. [ ] Claims ———— have been cancelled.

3. [ ] Claims ———— are allowed.

4. [X] Claims 1-4 are rejected.

5. [ ] Claims ———— are objected to

6. [ ] Claims — are subject to restriction or objection requirements

7. [ ] The formal drawings filed on — are acceptable

8. [ ] The drawing correction requests filed on—— has been [ ] approved [ ] disapproved

9. [ ] Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has

[ ] been received. [ ] not been received.

[ ] been filed in permit application, serial no. ———— filed on ————

10. [ ] Since this application appears to be in condition for allowance accept for formal matters, prosecution as to the merits is claimed in accordance with the practice under Ex parte quayle, 1935 C.D. 11; 453 O.G. 213.

11. [X] Other. No reference enclosed as all references are of record in the prior reissue application SN 834,136, abandoned.

PTOL-326 (rev. 7-79)

EXAMINER'S ACTION

[2] 1. Applicant's brief in support of this reissue application has urged a new issue which could not have been presented earlier is now presented by virtue of a newly filed affidavit by Robert C. McKee under 37 CFR

1.132, and citing: In re Herr, 153 USPQ 548 (CCPA 1967); In re Fisher, 166 USPQ 18 (CCPA 1970); In re Irish, 167 USPQ 764 (CCPA 1970); In re Russell, 169 USPQ 426 (CCPA 1971) in support thereof. The case law appears to support applicant's arguments.

2. The New and Supplemental Protest Of Chemtrol Adhesives, Inc., filed October 14, 1982 has been received. In a letter signed by C.K. Weiffenbach Examiner, Office of the Assistant Commissioner mailed August 25, 1982, paragraph V reads in part:

—"active participation by the protestor ends with the filing of its protest and no further submissions on behalf of the protestor will be acknowledged or considered and no further communications from the Office will be sent to the protestor unless such further submissions raise new issues which could not have been earlier presented such as to constitute a new protest."

The instant McKee affidavit raises a new issue as applicant admits.

3. Reply of Chemtrol To Morgan Response filed October 26, 1982 has been received.

[3] 4. 35 U.S.C. 103 reads:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be

negatived by the manner in which the invention was made".

5. Claims 1-3 are rejected under 35 U.S.C. 103, recited above, as being unpatentable over Karn in view of Brady ('732) or Brady, Jr. et al ('545).

This rejection assumes that the "potential tear line", score or indentation can be on that surface of the paper in contact with an adhesive. Each of Brady ('732) such as Figure 3 and Brady ('545) such as Figures 2 and 3 disclose a similar laminate having the tear line on the adhesive side of the paper. For the tear line of Karn to be on the adhesive side of the paper would be obvious in view of Brady ('732) or Brady ('545). The affidavit filed September 23, 1982 under 37 CFR 1.132 by Robert C. McKee has been given careful consideration, however, the affidavit is insufficient because: (1) there is no side-by-side comparison with the Karn reference which is a crush-cut product and not merely cut; (2) Karn and the instant [4] specification and claims are devoid of clay-coated Kraft paper. This is not an invitation to introduce new matter into the specification and/or claims; (3) the comparison must be identical with the disclosure of the reference, In re Tatincloux et al, 1956 GD 102 (CCPA); (4) it is elementary that the claims presented by applicant must distinguish from the reference disclosure, In re Crecilius, 1937 CD 112.

6. Claims 1-4 are rejected under 35 U.S.C. 103, recited above, as being unpatentable over Karn in view of Cameron Machine Co. Bulletin 4010 and Paper, Film and Foil Converter Publication.

This rejection assumes that there is some structural distinction in the configuration of the tear line of Karn. However, it would be obvious to employ the apparatus of the Bulletin 4010 and the converter publication which show rounded means conventionally used for scoring the paper in Karn. The affidavit referred to immediately above is insufficient for the same reasons given above.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by Karn because the invention was patented or described in a printed publication in this or a foreign country, more than one year prior to the date of the application for patent in the United States.

Especially note column 13, lines 8-12; column 2, lines 23-32; column 3, lines 51-64 and 70-73, and Figure 5. [5] The "crush-cutting" technique of Karn in column 3, lines 59 is presumed to yield appreciable compacting at the potential tear line. The "thin membranes" in column 3, line 59 and Figure 5 indicate that the paper backing layer is less than one-half of its uncompacted thickness at the potential tear line.

8. Claims 1-4 are rejected on the ground of *res judicata*. The instant micrometer steps or variable pressures in the affidavit is assumed to be a mere amplification of issues in the prior McKee affidavit paper No. 32½ filed October 15, 1979 (cutting limited by rollers or variable pressures), and the Ferrell affidavit paper No. 37 filed January 10, 1980 (cutting limited by bears), the two latter affidavits filed in prior reissue application SN 834,136, now abandoned. Thus, the case law, especially In re Russell 169 USPQ 426 (CCPA 1971) cited by applicant sup-

ports the Examiner's position in this rejection of all claims.

9. In re Dien 214 USPQ 10, suggests one advisory opinion by the Board of Appeals on the same claims as are contained in the patent is enough; even when claims are canceled in In re Bose, 215 USPQ 1.

/s/ W. J. Van Balen
PRIMARY EXAMINER
ART UNIT 164

WJVanBalen:ckg
(703) 557-1897
11-01-82
FORM PTO 897
(REV. 3-78)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED
Serial No. 301140, Group Art Unit 164,
Attachment to Paper Number

APPLICANT(S) Burton D. Morgan

U.S. PATENT DOCUMENTS

	Document No.	Date	Name	Class	Sub-class	Filing Date If Appropriate
✓	A 2 3 1 9 2 7 2	5/1943	Starr	428	43	
✓	B 2 4 3 4 5 4 5	1/1948	Brady, Jr., et al.	40	2R	
✓	C 2 6 3 6 2 9 7	4/1953	Johnson	428	41	
✓	D 2 6 8 1 7 3 2	6/1954	Brady	428	41	
✓	E 2 8 0 0 2 1 4	7/1957	Symonds	428	41	
✓	F 2 9 5 6 7 0 3	10/1960	Royal	428	41	
✓	G 3 0 0 6 7 9 3	10/1961	Wheeler, III	428	41	
✓	H 3 0 2 8 2 8 0	4/1962	Hoffman	428	40	
✓	I 3 0 3 1 3 5 9	4/1962	Blank, et al.	428	77	
✓	J 3 0 3 5 9 5 7	5/1962	Morgan	428	41	
✓	K 3 2 3 0 6 4 9	1/1966	Karn	40	2R	

FOREIGN PATENT DOCUMENTS

Document No., Date, Country, Name, Class, Subclass, Pertinent (Illegible)

L
M
N
O
P
Q

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

✓ R Bulletin 4010, Cameron Machine Co., Dover, New Jersey (no date.)

✓ S "Paper, Film and Foil Converter", July 1958, pages 24-28

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EXAMINER WILLIAM J. VAN BALEN, PRIMARY EXAMINER ART UNIT 164, Date 10/1/82

A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05(a).)

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

Civil Action No. C-76-101A

JUDGE JOHN M. MANOS

MORGAN ADHESIVES COMPANY,

Plaintiff,

vs.

CHEMTROL ADHESIVES, INC.,

Defendant.

BRIEF IN SUPPORT OF PLAINTIFF'S MOTION TO STAY PROCEEDINGS

On March 1, 1977, the USPTO placed into effect a new rule, 35 CFR 1.175 (1977), which allows a patentee to obtain reconsideration of a patent in view of prior art and other information relevant to patentability which may not have been previously considered by the USPTO. The announcement of the new rule was prefaced by an introduction stating that "a Federal Court may, if it chooses, stay proceedings" of litigation during the pendency of the reissue application. 955 *Official Gazette* USPTO 1054 (February 22, 1977). On Friday, September 16, 1977, Morgan forwarded a reissue application to the USPTO and files herewith PLAINTIFF'S MOTION TO STAY PROCEEDINGS pending the outcome of that reissue application.

While a grant or denial of the stay is within the sound discretion of the Court, it is urged that the requested stay will achieve the most efficient disposition

of this litigation without prejudicing the rights of the parties thereto. Chemtrol has argued in Exhibits A and B to its ANSWER AND COUNTERCLAIM and in its BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT that had the Karn, Starr, and two Brady patents been before the USPTO during the prosecution of U.S. Patent No. 3,900,645, that patent would not have issued. The new rules of practice promulgated by the USPTO provide a means to determine whether or not there is merit to such an allegation.

The greatest expertise respecting the applicability of prior art to the claimed invention resides in the USPTO and the new rule provides the vehicle by which the Court may avail itself of such expertise. Further, a substantial savings in time, money, and energy of not only the parties but also the Court will be realized if all concerned are allowed to gain the benefit of the consideration given by the USPTO to the issue of applicability of the Karn, Starr, and Brady references to the claimed invention.

A further amendment to the rules, 35 CFR 1.291 (1977), allows members of the public to bring to the attention of the Patent Examiner such prior art, and papers related thereto, as may be deemed relevant to a patent's prosecution. Chemtrol is thus afforded an opportunity to advise the USPTO of its position regarding the applicability of the referenced prior art or any other prior art of which it may become aware. Full consideration may thus be made of the prior art issues at bar via the expertise of the USPTO.

The requested stay of proceedings should not be a lengthy one in that reissue applications are treated as

"special" and "will be acted on by the Examiner in advance of other applications." 37 CFR 1.176 (1977), and *Manual of Patent Examining Procedures* Section 1401.09 (1976). Morgan hereby assures this Court that it will make every effort to expedite the prosecution of its reissue application in order that the Court may have the benefit of the analysis of the USPTO at the earliest possible date. Plaintiff will further make every reasonable effort to be prepared to promptly resume such proceedings at the termination of the prosecution of the reissue application.

Respectfully submitted,

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MORGAN'S REQUEST FOR ADDITIONAL TIME FOR ORAL ARGUMENT BEFORE THE PATENT BOARD OF APPEALS

(Filed August 27, 1980)

REQUEST FOR ADDITIONAL TIME FOR ORAL ARGUMENT

Sir:

The undersigned, attorney for appellant, requests that he be granted an additional ten (10) minutes for oral argument at the hearing scheduled for September 18, 1980, 1:00 P.M. It is particularly requested that five (5) additional minutes be granted for the presentation of appellant's case in chief and that five (5) minutes be provided for rebuttal following the protestor's oral arguments.

The Examiner has maintained five bases of rejection, each of which is brought to the Board on appeal. Each such rejection will require attention at the hearing. If the request is granted, appellant will be provided with twenty-five (25) minutes for his case in chief, or five (5) minutes per main issue.

[2] The need for additional time to fairly present appellant's case is further supported by the sheer volume of material lodged during the prosecution before the Examiner and before this Board on appeal. To briefly touch upon selected topics of those listed in the Table of Contents of Appellant's Appeal Brief will require at least the additional time requested.

In keeping with proper procedure for *inter partes* hearings the moving party (appellant) should be alloted time to rebut arguments of the protestor and to attend to

any new issues which might be raised by the protestor during the oral argument. The requested five (5) minute rebuttal period would afford appellant a minimum of time necessary for a full and fair hearing.

Favorable action on the foregoing request is most earnestly and respectfully solicited from your Honorable Board of Appeals.

Respectfully submitted,

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